

REMARKS

The last Office Action of December 19, 2008 has been carefully considered. Reconsideration of the instant application in view of the foregoing amendments and the following remarks is respectfully requested.

Claims 1-10 are pending in the application. Claims 1-2 have been amended. Claim 11 has been added. No amendment to the specification has been made. No fee is due.

Claims 1-10 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-4, 7-9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Japanese Patent Document JP 2001-123248A to Okui et al. (hereinafter "JP '248") in view of European Patent Document EP 1083237A2 to Ota et al. (hereinafter "EP '237").

Claims 5-6, 10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over JP '248 in view of EP '237, and further in view of Japanese Patent Document JP 60-213246 to Baba (hereinafter "JP '246").

REJECTION UNDER 35 U.S.C. §112, SECOND PARAGRAPH

Applicant has amended claim 1 by deleting the reference to "spring rail for wipers". This recitation has now been considered in newly presented claim 11 which is dependent on claim 1.

Withdrawal of the rejection under 35 U.S.C. §112, second paragraph is thus respectfully requested.

REJECTION UNDER 35 U.S.C. §103(a)

Applicant respectfully disagrees with the Examiner's rejection of claim 1 for the

following reasons:

Applicant has amended claim 1 by limiting the range of molybdenum and vanadium to distinguish from the applied prior art. Claims 2 and 3 have been amended to make them consistent with the changes to claim 1. In this context, reference is made to MPEP 2163.05(III) which is duplicated here for the benefit of the Examiner:

III. RANGE LIMITATIONS

With respect to changing numerical range limitations, the analysis must take into account which ranges one skilled in the art would consider inherently supported by the discussion in the original disclosure. In the decision in *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976), the ranges described in the original specification included a range of "25%-60%" and specific examples of "36%" and "50%." A corresponding new claim limitation to "at least 35%" did not meet the description requirement because the phrase "at least" had no upper limit and caused the claim to read literally on embodiments outside the "25% to 60%" range, however a limitation to "between 35% and 60%" did meet the description requirement.

As clearly and unequivocally set forth in this section, even though a certain range may not find literal support in the specification, the description requirement is met, when the indicated range falls within the range that has been literally disclosed in the specification.

In the case at hand, the range for molybdenum, as originally defined, was 0.1 to 2%. A limitation of "0.1 to <0.5%" thus falls within the originally disclosed range and thus meets the description requirement. Likewise, the range for vanadium, as originally defined, was 0.02 to 0.25%. A limitation of ">0.15 to 0.25%" thus falls within the originally disclosed range and thus meets the description requirement

Moreover, it is applicant's contention that the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Gorman*, 933 F.2d 982. In the case at hand, there is no reason for a person skilled in the art to look

at EP '237 and to find motivation to take the disclosure of, for example, "molybdenum" or "vanadium" for incorporation into the ferritic steel composition in JP '248, when the EP '237 relates to steel composition that is characterized by its ductility, formability, and anti-ridging properties, i.e. properties that have nothing in common with elasticity or springiness. This arbitrary approach demonstrated by the Examiner to simply take one element in isolation from one steel composition that lacks necessary ingredient of another steel composition and contains elements lacking in the other steel composition, and to incorporate this element in the other steel composition goes against common sense so that an artisan at the time the invention was made would not have reasonably considered embedding molybdenum and vanadium within the existing steel composition disclosed in JP '248 in the manner suggested by the examiner. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d at 902.

An alloying ingredient is defined in two ways, namely by material and by quantity, and becomes effective only in concert with other alloying elements because the property of an alloy depends on the type and quantity of all alloying elements. Even though alloys may have same or similar properties, their composition may greatly vary, so that an assumed property of an alloy itself is secondary and cannot be used as basis to formulate a desired composition. In other words, depending on its quantity and the type and quantity of other alloying elements, a particular element may have a positive effect, or a negative effect, or no effect at all. In the case of arsenic, it may have a brittle effect in the steel and impede the hot forming property if there are no other counteracting alloying elements.

Thus, the mere fact that one steel composition contains a particular alloying element by itself means nothing because it develops its effect only in combination with other alloying elements. Thus, an artisan in the field of metallurgy will not look at an alloying element in isolation and assume a particular effect in another steel composition as a result of using this alloying element. The approach taken by the

Examiner to pick and choose among individual portions of various prior art references as a mosaic to recreate a facsimile of the claimed invention is therefore ill-advised. The JP '248 JP and EP '237 references were combined piecemeal without any suggestion or motivation for their combination and without regard to the purpose of applicant's invention.

For the reasons set forth above, it is applicant's contention that neither JP '248 nor EP '237, nor a combination thereof teaches or suggests the features of the present invention, as recited in claim 1.

As for the rejection of the retained dependent claims, these claims depend on claim 1, share its presumably allowable features, and therefore it is respectfully submitted that these claims should also be allowed.

CITED REFERENCES

Applicant has also carefully scrutinized the further cited prior art and finds it without any relevance to the claims on file. It is thus felt that no specific discussion thereof is necessary.

CONCLUSION

In view of the above presented remarks and amendments, it is respectfully submitted that all claims on file should be considered patentably differentiated over the art and should be allowed.


Reconsideration and allowance of the present application are respectfully requested.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully requested that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. If the Examiner feels that it might be

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helpful in advancing this case by calling the undersigned, applicant would greatly appreciate such a telephone interview.

Respectfully submitted,

By: 
Henry M. Feiereisen
Agent For Applicant
Reg. No: 31,084

Date: April 17, 2009
708 Third Avenue
Suite 1501
New York, N.Y. 10017
(212)244-5500
HMF:be